

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD_____
BARLOW DESIGNS, INC.

Petitioner,

v.

ALLAN T. HAO CHIN,

Respondent.

Cancellation No. 92058690

Registration No. 3,593,654

PETITIONER'S THIRD NOTICE OF RELIANCE

PLEASE TAKE NOTICE that, pursuant to Rule 2.122 of the Trademark Rules of Practice, Petitioner Barlow Designs, Inc. hereby makes of record and will rely upon the following documents, copies of which are attached hereto.

5. Certified copy of the file history of Application Serial No. 86/017,272, owned by Petitioner. This document is relevant to the issue of Petitioner's standing.

BARLOW DESIGNS, INC.



John L. Welch
Lando & Anastasi, LLP
One Main Street, Eleventh Floor
Cambridge, MA 02142
617-395-7000



CERTIFICATE OF SERVICE

I hereby certify that the foregoing document was served upon Respondent this 10th day of April, 2015, by mailing a copy thereof via first-class mail, postage pre-paid, to Brian Edward Banner, Esq., The Banner Firm, LLC, 2734 Unicorn Lane, N.W., Washington, D.C. 20015.

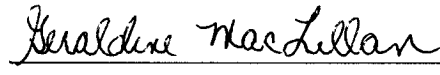
A handwritten signature in black ink, reading "John L. Welch". The signature is written in a cursive style with a large, looping "J" and "W".

John L. Welch
Lando & Anastasi, LLP
One Main Street, Eleventh Floor
Cambridge, MA 02142
617-395-7000

Certificate of Express Mailing

I hereby certify that the enclosed materials are being deposited with the United States Postal Service as Express Mail Label No. EB575685634US under 37 CFR 2.198 in an envelope addressed to Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451 on the date set forth below.

Dated: April 10, 2015



Geraldine MacLellan

Cancellation No. 92058690

Petitioner's Notice of Reliance

Exhibit 5

7513872



THE UNITED STATES OF AMERICA

TO ALL TO WHOM THESE PRESENTS SHALL COME:

**UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office**

January 27, 2015

**THIS IS TO CERTIFY THAT ANNEXED IS A TRUE COPY FROM THE
RECORDS OF THIS OFFICE OF THE TRADEMARK FILE WRAPPER AND
CONTENTS OF:**

TRADEMARK APPLICATION: 86/018,272

FILING DATE: *July 24, 2013*

**By Authority of the
Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark Office**

**T. LAWRENCE
Certifying Officer**



PTO Form 1478 (Rev 9/2008)
OMB No. 0651-0009 (Exp 12/31/2014)

Trademark/Service Mark Application, Principal Register

TEAS Plus Application

Serial Number: 86018272

Filing Date: 07/24/2013

*NOTE: Data fields with the * are mandatory under TEAS Plus. The wording "(if applicable)" appears where the field is only mandatory under the facts of the particular application.*

The table below presents the data as entered.

Input Field	Entered
TEAS Plus	YES
MARK INFORMATION	
*MARK	<u>PERIWINKLE</u>
*STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	PERIWINKLE
*MARK STATEMENT	The mark consists of standard characters, without claim to any particular font, style, size, or color.
REGISTER	Principal
APPLICANT INFORMATION	
*OWNER OF MARK	Barlow Designs, Inc.
*STREET	20 Commercial Way
*CITY	East Providence
*STATE (Required for U.S. applicants)	Rhode Island
*COUNTRY	United States
*ZIP/POSTAL CODE (Required for U.S. applicants only)	02914
LEGAL ENTITY INFORMATION	

*TYPE	CORPORATION
* STATE/COUNTRY OF INCORPORATION	Rhode Island
GOODS AND/OR SERVICES AND BASIS INFORMATION	
*INTERNATIONAL CLASS	025
*IDENTIFICATION	Footwear; Sandals; Sandals and beach shoes; Shoes
*FILING BASIS	SECTION 1(b)
ADDITIONAL STATEMENTS INFORMATION	
*TRANSLATION (if applicable)	
*TRANSLITERATION (if applicable)	
*CLAIMED PRIOR REGISTRATION (if applicable)	
*CONSENT (NAME/LIKENESS) (if applicable)	
*CONCURRENT USE CLAIM (if applicable)	
ATTORNEY INFORMATION	
NAME	Robert J Doherty
FIRM NAME	Robert J Doherty ,Esq
STREET	10 George St
CITY	Barrington
STATE	Rhode Island
COUNTRY	United States
ZIP/POSTAL CODE	02806
PHONE	401 431 1320
EMAIL ADDRESS	nockumhill@hughes.net
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
CORRESPONDENCE INFORMATION	
*NAME	Robert J Doherty
FIRM NAME	Robert J Doherty ,Esq
*STREET	10 George St

*CITY	Barrington
*STATE (Required for U.S. applicants)	Rhode Island
*COUNTRY	United States
*ZIP/POSTAL CODE	02806
PHONE	401 431 1320
*EMAIL ADDRESS	nockumhill@hughes.net
*AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
FEE INFORMATION	
NUMBER OF CLASSES	1
FEE PER CLASS	275
*TOTAL FEE PAID	275
SIGNATURE INFORMATION	
* SIGNATURE	/robert j doherty/
* SIGNATORY'S NAME	Robert J Doherty
* SIGNATORY'S POSITION	Attorney, member RI bar
SIGNATORY'S PHONE NUMBER	401 431 1320
* DATE SIGNED	07/24/2013

PTO Form 1478 (Rev 9/2006)

OMB No. 0651-0009 (Exp 12/31/2014)

Trademark/Service Mark Application, Principal Register**TEAS Plus Application****Serial Number: 86018272****Filing Date: 07/24/2013****To the Commissioner for Trademarks:****MARK:** PERIWINKLE (Standard Characters, see mark)

The literal element of the mark consists of PERIWINKLE.

The mark consists of standard characters, without claim to any particular font, style, size, or color.

The applicant, Barlow Designs, Inc., a corporation of Rhode Island, having an address of
20 Commercial Way
East Providence, Rhode Island 02914
United States

requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended, for the following:

For specific filing basis information for each item, you must view the display within the Input Table.

International Class 025: Footwear; Sandals; Sandals and beach shoes; Shoes

Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services. (15 U.S.C. Section 1051(b)).

The applicant's current Attorney Information:

Robert J Doherty of Robert J Doherty ,Esq
10 George St
Barrington, Rhode Island 02806
United States

The applicant's current Correspondence Information:

Robert J Doherty
Robert J Doherty ,Esq
10 George St
Barrington, Rhode Island 02806
401 431 1320(phone)

nockumhill@hughes.net (authorized)

A fee payment in the amount of \$275 has been submitted with the application, representing payment for 1 class(es).

Declaration

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

Signature: /robert j doherty/ Date Signed: 07/24/2013

Signatory's Name: Robert J Doherty

Signatory's Position: Attorney, member RI bar

RAM Sale Number: 86018272

RAM Accounting Date: 07/24/2013

Serial Number: 86018272

Internet Transmission Date: Wed Jul 24 09:30:07 EDT 2013

TEAS Stamp: USPTO/FTK-69.35.201.186-2013072409300778

3552-86018272-5005e36660126a13f682994c5f

dade0988ea5edf3ab112fcaa279e9ecbe6a4c-C

C-10638-20130724091646004219

PERIWINKLE

*** User:jfalk ***

#	Total Marks	Dead Marks	Live Viewed Docs	Live Viewed Images	Status/ Search Duration	Search
01	18	0	18	16	0:02	*p{v}r{v}w{v}n*[bi,ti] and live[ld]

Session started 11/6/2013 5:31:42 PM
Session finished 11/6/2013 5:35:46 PM
Total search duration 0 minutes 2 seconds
Session duration 4 minutes 4 seconds
Default NEAR limit=1ADJ limit=1

Sent to TIGRS as Serial Number: 86018272

*** User:jfalk ***

#	Total Marks	Dead Marks	Live Viewed Docs	Live Viewed Images	Status/ Search Duration	Search
01	18	0	18	16	0:02	*p{v}r{v}w{v}n*[bi,ti] and live[ld]
02	19	0	19	17	0:01	*p{v}{r"1:2}{v}w{v}n*[bi,ti] and live[ld]

Session started 11/6/2013 5:31:42 PM
Session finished 11/6/2013 5:59:26 PM
Total search duration 0 minutes 3 seconds
Session duration 27 minutes 44 seconds
Default NEAR limit=1ADJ limit=1

Sent to TICRS as Serial Number: 86018272

*** User:jfalk ***

#	Total Marks	Dead Marks	Live Viewed Docs	Live Viewed Images	Status/ Search Duration	Search
01	18	0	18	16	0:02	*p{v}r{v}w{v}n*[bi,ti] and live[ld]

Session started 11/6/2013 5:31:42 PM
Session finished 11/6/2013 5:35:46 PM
Total search duration 0 minutes 2 seconds
Session duration 4 minutes 4 seconds
Default NEAR limit=1ADJ limit=1

Sent to TICRS as Serial Number: 86018272

*** User:jfalk ***

#	Total Marks	Dead Marks	Live Viewed Docs	Live Viewed Images	Status/ Search Duration	Search
01	18	0	18	16	0:02	*p{v}{r}{v}w{v}n*[bi,ti] and live[ld]
02	19	0	19	17	0:01	*p{v}{r"1:2}{v}w{v}n*[bi,ti] and live[ld]

Session started 11/6/2013 5:31:42 PM
Session finished 11/6/2013 5:59:26 PM
Total search duration 0 minutes 3 seconds
Session duration 27 minutes 44 seconds
Default NEAR limit=1ADJ limit=1

Sent to TIGRS as Serial Number: 86018272

PERIWINKLE

DESIGN MARK

Serial Number

77053544

Status

CANCELLATION PENDING

Word Mark

PERIWINKLE

Standard Character Mark

Yes

Registration Number

3285250

Date Registered

2007/08/28

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

Barlow Designs Inc. CORPORATION RHODE ISLAND 20 Commercial Way East
Providence RHODE ISLAND 02914

Goods/Services

Class Status -- ACTIVE. IC 014. US 002 027 028 050. G & S:
Bracelets; Charms; Costume jewelry; Earrings; Jewelry; Necklaces.
First Use: 2002/11/15. First Use In Commerce: 2002/11/15.

Filing Date

2006/11/29

Examining Attorney

LAWRENCE, SUE

Attorney of Record

Robert J Doherty

PERIWINKLE

DESIGN MARK

Serial Number

77121895

Status

REGISTERED

Word Mark

PERIWINKLE

Standard Character Mark

Yes

Registration Number

3593654

Date Registered

2009/03/24

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

Hao Chin, Allan T. INDIVIDUAL PHILIPPINES 143 Maria Clara St., Talayan Village Quezon City PHILIPPINES 1101

Goods/Services

Class Status -- ACTIVE. IC 025. US 022 039. G & S: Children's clothing, namely, dresses, blouses, pants, shorts, skirts, hats, caps, bandanas, headbands, shoes, shoes in the nature of sandals, panties, under shorts and briefs, shirts, polo shirts, shorts, and waterproof jackets. First Use: 2003/06/16. First Use In Commerce: 2007/02/00.

Foreign Country Name

PHILIPPINES

Foreign Priority

FOREIGN PRIORITY CLAIMED

Foreign Application Number

42006010332

Foreign Filing Date

2006/09/18

Foreign Registration Number

42006010332

Foreign Registration Date

2007/10/29

Foreign Expiration Date

2017/10/29

Filing Date

2007/03/05

Examining Attorney

STEPHENS, SONYA

periwinkle

DESIGN MARK

Serial Number

78518029

Status

CANCELLATION PENDING

Word Mark

PERIWINKLE

Standard Character Mark

Yes

Registration Number

3335997

Date Registered

2007/11/13

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

Barlow Designs, Inc. CORPORATION RHODE ISLAND 20 Commercial Way East
Providence RHODE ISLAND 02914

Goods/Services

Class Status -- ACTIVE. IC 018. US 001 002 003 022 041. G & S:
Handbags, purses, clutches and wallets. First Use: 2005/01/15. First
Use In Commerce: 2005/01/15.

Filing Date

2004/11/16

Examining Attorney

IM, JEAN

Attorney of Record

Robert J Doherty

PERIWINKLE

DESIGN MARK

Serial Number

85106996

Status

REPORT COMPLETED SUSPENSION CHECK - CASE STILL SUSPENDED

Word Mark

PERRYWINKLE'S

Standard Character Mark

Yes

Type of Mark

TRADEMARK; SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

The Sporn Company, Inc. CORPORATION NEW YORK 227 Main Street
Burlington VERMONT 05401

Goods/Services

Class Status -- ACTIVE. IC 014. US 002 027 028 050. G & S: jewelry
and diamonds. First Use: 1999/03/31. First Use In Commerce:
1999/03/31.

Goods/Services

Class Status -- ACTIVE. IC 035. US 100 101 102. G & S: retail
store services featuring jewelry, diamonds, watches, and handbags, all
for adults. First Use: 1999/03/31. First Use In Commerce:
1999/03/31.

Filing Date

2010/08/13

Examining Attorney

TURNER, JASON

Attorney of Record

Peter Kunin

PERRYWINKLE'S

DESIGN MARK

Serial Number

85540923

Status

REPORT COMPLETED SUSPENSION CHECK - CASE STILL SUSPENDED

Word Mark

PERIWINKLE

Standard Character Mark

No

Type of Mark

SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(3) DESIGN PLUS WORDS, LETTERS AND/OR NUMBERS

Owner

Periwinkle, LLC LIMITED LIABILITY COMPANY VIRGINIA 5054 South 22nd Street Arlington VIRGINIA 22206

Goods/Services

Class Status -- ACTIVE. IC 035. US 100 101 102. G & S: On-line retail gift shops; On-line retail store services featuring clothing, fashion, and accessories; Retail apparel stores; Retail clothing boutiques; Retail department store services; Retail gift shops; Retail jewelry stores. First Use: 2005/10/01. First Use In Commerce: 2005/10/01.

Description of Mark

The mark consists of the literal text "periwinkle" horizontally displayed in lower case type with an image of a flower containing six (6) lavender blue petals, outlined in black, positioned both to the left and right of the text. A lavender blue oval is centered on the text and flower images and encircles the same. All of the foregoing is encircled by a bold black oval that is slightly larger than the lavender blue oval. All of the foregoing is overlaid on a white background.

Colors Claimed

The color(s) white, periwinkle, otherwise known as lavender blue, and black is/are claimed as a feature of the mark.

Filing Date

2012/02/13

Print: Nov 8, 2013

85540923

Examining Attorney
SWIFT, GILBERT

Attorney of Record
Michael Chamowitz



DESIGN MARK

Serial Number

85647204

Status

REPORT COMPLETED SUSPENSION CHECK - CASE STILL SUSPENDED

Word Mark

PERIWINKLE

Standard Character Mark

Yes

Type of Mark

SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

Periwinkle, LLC DBA Periwinkle LIMITED LIABILITY COMPANY VIRGINIA 5054
South 22nd Street Alexandria VIRGINIA 22206

Goods/Services

Class Status -- ACTIVE. IC 035. US 100 101 102. G & S: On-line retail gift shops; On-line retail store services featuring clothing, fashion, and accessories; Retail apparel stores; Retail clothing boutiques; Retail department store services; Retail gift shops; Retail jewelry stores. First Use: 2005/10/01. First Use In Commerce: 2005/10/01.

Filing Date

2012/06/08

Examining Attorney

SWIFT, GILBERT

Attorney of Record

Michael J. Chamowitz

Periwinkle

To: Barlow Designs, Inc. (nockumhill@hughes.net)
Subject: U.S. TRADEMARK APPLICATION NO. 86018272 - PERIWINKLE - N/A
Sent: 11/7/2013 9:54:59 AM
Sent As: ECOM111@USPTO.GOV
Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

**IMPORTANT NOTICE REGARDING YOUR
U.S. TRADEMARK APPLICATION**

USPTO OFFICE ACTION (OFFICIAL LETTER) HAS ISSUED
ON **11/7/2013** FOR U.S. APPLICATION SERIAL NO. 86018272

Please follow the instructions below:

(1) TO READ THE LETTER: Click on this [link](#) or go to <http://tsdr.uspto.gov>, enter the U.S. application serial number, and click on "Documents."

The Office action may not be immediately viewable, to allow for necessary system updates of the application, but will be available within 24 hours of this e-mail notification.

(2) TIMELY RESPONSE IS REQUIRED: Please carefully review the Office action to determine (1) how to respond, and (2) the applicable response time period. Your response deadline will be calculated from **11/7/2013** (*or sooner if specified in the Office action*). For information regarding response time periods, see <http://www.uspto.gov/trademarks/process/status/responsetime.jsp>.

Do NOT hit "Reply" to this e-mail notification, or otherwise e-mail your response because the USPTO does NOT accept e-mails as responses to Office actions. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System (TEAS) response form located at http://www.uspto.gov/trademarks/teas/response_forms.jsp.

(3) QUESTIONS: For questions about the contents of the Office action itself, please contact the assigned trademark examining attorney. For *technical* assistance in accessing or viewing the Office action in the Trademark Status and Document Retrieval (TSDR) system, please e-mail TSDR@uspto.gov.

WARNING

Failure to file the required response by the applicable response deadline will result in the ABANDONMENT of your application. For more information regarding abandonment, see <http://www.uspto.gov/trademarks/basics/abandon.jsp>.

PRIVATE COMPANY SOLICITATIONS REGARDING YOUR APPLICATION: Private companies **not** associated with the USPTO are using information provided in trademark applications to mail or e-mail trademark-related solicitations. These companies often use names that closely resemble the USPTO and their solicitations may look like an official government document. Many solicitations require that you pay “fees.”

Please carefully review all correspondence you receive regarding this application to make sure that you are responding to an official document from the USPTO rather than a private company solicitation. All official USPTO correspondence will be mailed only from the “United States Patent and Trademark Office” in Alexandria, VA; or sent by e-mail from the domain “@uspto.gov.” For more information on how to handle private company solicitations, see http://www.uspto.gov/trademarks/solicitation_warnings.jsp.

To: Barlow Designs, Inc. (nockumhill@hughes.net)
Subject: U.S. TRADEMARK APPLICATION NO. 86018272 - PERIWINKLE - N/A
Sent: 11/7/2013 9:54:59 AM
Sent As: ECOM111@USPTO.GOV
Attachments: [Attachment - 1](#)
[Attachment - 2](#)
[Attachment - 3](#)
[Attachment - 4](#)
[Attachment - 5](#)
[Attachment - 6](#)
[Attachment - 7](#)
[Attachment - 8](#)
[Attachment - 9](#)
[Attachment - 10](#)
[Attachment - 11](#)
[Attachment - 12](#)
[Attachment - 13](#)
[Attachment - 14](#)

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

U.S. APPLICATION SERIAL NO. 86018272

MARK: PERIWINKLE

86018272

CORRESPONDENT ADDRESS:

ROBERT J DOHERTY
ROBERT J DOHERTY ,ESQ
10 GEORGE ST
BARRINGTON, RI 02806-1719

CLICK HERE TO RESPOND TO THIS LETTER:
http://www.uspto.gov/trademarks/teas/response_forms.jsp

APPLICANT: Barlow Designs, Inc.

CORRESPONDENT'S REFERENCE/DOCKET

NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

nockumhill@hughes.net

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 11/7/2013

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP

file:///D:/p2mp/temp/html/OEMS.htm

1/14/2015

§§711, 718.03.

SUMMARY OF ISSUES that applicant must address:

- Likelihood of Confusion Refusal
- Prior Pending Applications May Bar Registration
- Prior Registration Must be Claimed

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 3593654. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the enclosed registration.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods of the applicant and registrant. *See* 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods, and similarity of the trade channels of the goods. *See In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

COMPARISON OF THE MARKS

In a likelihood of confusion determination, the marks in their entireties are compared for similarities in appearance, sound, connotation, and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b)-(b)(v).

In the present case, applicant's mark is PERIWINKLE and registrant's mark is PERIWINKLE. Thus, the marks are identical in terms of appearance and sound. In addition, the connotation and commercial impression of the marks do not differ when considered in connection with applicant's and registrant's respective goods and/or services.

Therefore, the marks are confusingly similar.

COMPARISON OF THE GOODS

Applicant's goods are footwear, specifically: "Footwear; Sandals; Sandals and beach shoes; Shoes."

Registrant's goods are children's clothing including footwear, specifically: "Children's clothing, namely, dresses, blouses, pants, shorts, skirts, hats, caps, bandanas, headbands, shoes, shoes in the nature of sandals, panties, under shorts and briefs, shirts, polo shirts, shorts, and waterproof jackets."

As the case law shows, applicant's and registrant's goods are commercially related.

The goods of the parties need not be identical or even competitive to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v.*

Becton, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”); TMEP §1207.01(a)(i). However, in this matter, the goods are nearly identical.

With respect to applicant’s and registrant’s goods, the question of likelihood of confusion is determined based on the description of the goods stated in the application and registration at issue, not on extrinsic evidence of actual use. *See, e.g., Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-70, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012); *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Absent restrictions in an application and/or registration, the identified goods are “presumed to travel in the same channels of trade to the same class of purchasers.” *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Additionally, unrestricted and broad identifications are presumed to encompass all goods and/or services of the type described. *See In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

In this case, the identification set forth in the application and registration has no restrictions as to nature, type, channels of trade, or classes of purchasers. Therefore, it is presumed that these goods travel in all normal channels of trade, and are available to the same class of purchasers. Further, the application uses broad wording to describe the goods and this wording is presumed to encompass all goods of the type described, including those in registrant’s more narrow identification, namely, shoes include children’s shoes.

In total, the two marks create the same commercial impression and the evidence shows that the goods are commercially related and likely to be encountered together in the marketplace by consumers. Therefore, consumers are likely to be confused and mistakenly believe that the goods originate from a common source. Therefore, there is a likelihood of confusion and registration must be refused under Section 2(d) of the Lanham Act.

PRIOR-FILED APPLICATIONS

The filing dates of pending U.S. Application Serial Nos. 85106996, 85540923, and 85647204 precede applicant’s filing date. *See* attached referenced applications. If one or more of the marks in the referenced applications register, applicant’s mark may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion with the registered mark(s). *See* 15 U.S.C. §1052(d); 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon receipt of applicant’s response to this Office action, action on this application may be suspended pending final disposition of the earlier-filed referenced applications. It is noted that all three prior-filed applications are currently suspended pending cancellation proceedings filed by the owner of U.S. Application Serial No. 85106996 against applicant’s prior registrations discussed below.

In response to this Office action, applicant may present arguments in support of registration by addressing the issue of the potential conflict between applicant’s mark and the marks in the referenced applications. Applicant’s election not to submit arguments at this time in no way limits applicant’s right to address this issue later if a refusal under Section 2(d) issues.

CLAIM OF OWNERSHIP OF REGISTRATIONS

If applicant owns U.S. Registration Nos. 3285250 and 3335997, then applicant must submit for the application record a claim of ownership of these registrations. *See* 37 C.F.R. §2.36; TMEP §812. *See* the attached copy of the registrations. *See* TMEP §812.

Applicant may use the following format to claim ownership of the registration:

Applicant is the owner of U.S. Registration Nos. 3285250 and 3335997.

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. *See* 37 C.F.R. §2.191; TMEP §§304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal(s) and/or requirement(s) in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. *See* TMEP §§705.02, 709.06.

TEAS PLUS APPLICANTS MUST SUBMIT DOCUMENTS ELECTRONICALLY OR SUBMIT FEE: Applicants who filed their application online using the reduced-fee TEAS Plus application must continue to submit certain documents online using TEAS, including responses to Office actions. *See* 37 C.F.R. §2.23(a)(1). For a complete list of these documents, see TMEP §819.02(b). In addition, such applicants must accept correspondence from the Office via e-mail throughout the examination process and must maintain a valid e-mail address. 37 C.F.R. §2.23(a)(2); TMEP §§819, 819.02(a). TEAS Plus applicants who do not meet these requirements must submit an additional fee of \$50 per international class of goods and/or services. 37 C.F.R. §2.6(a)(1)(iv); TMEP §819.04. In appropriate situations and where all issues can be resolved by amendment, responding by telephone to authorize an examiner's amendment will not incur this additional fee.

/Jonathan R. Falk/
Trademark Examining Attorney
Law Office 111
(571)272-5301
jonathan.falk@uspto.gov

TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/ mailing date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.

PTO Form 1957 (Rev 9/2005)
OMB No. 0651-0050 (Exp. 07/31/2017)

Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86018272
LAW OFFICE ASSIGNED	LAW OFFICE 111
MARK SECTION (no change)	
ARGUMENT(S)	
Suspension of further action in this application is requested in light of the filing of a cancellation action of registration 3593654.	
SIGNATURE SECTION	
RESPONSE SIGNATURE	/robert j doherty/
SIGNATORY'S NAME	Robert J Doherty
SIGNATORY'S POSITION	Attorney, member RI bar
SIGNATORY'S PHONE NUMBER	401 431 1320
DATE SIGNED	03/09/2014
AUTHORIZED SIGNATORY	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Sun Mar 09 10:28:56 EDT 2014
TEAS STAMP	USPTO/ROA-69.35.201.184-2 0140309102856833049-86018 272-500da47e1beba1e502ed8 39bd14188b9573465ac287dd3 fd473dd0f26c7a1d25-N/A-N/ A-20140309102045136306

PTO Form 1957 (Rev 9/2005)
OMB No. 0651-0050 (Exp. 07/31/2017)

Response to Office Action**To the Commissioner for Trademarks:**

Application serial no. **86018272** has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

Suspension of further action in this application is requested in light of the filing of a cancellation action of registration 3593654.

SIGNATURE(S)**Response Signature**

Signature: /robert j doherty/ Date: 03/09/2014

Signatory's Name: Robert J Doherty

Signatory's Position: Attorney, member RI bar

Signatory's Phone Number: 401 431 1320

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

Serial Number: 86018272

Internet Transmission Date: Sun Mar 09 10:28:56 EDT 2014

TEAS Stamp: USPTO/ROA-69.35.201.184-2014030910285683

3049-86018272-500da47e1beba1e502ed839bd1

4188b9573465ac287dd3fd473dd0f26c7a1d25-N

/A-N/A-20140309102045136306

To: Barlow Designs, Inc. (nockumhill@hughes.net)
Subject: U.S. TRADEMARK APPLICATION NO. 86018272 - PERIWINKLE - N/A
Sent: 3/14/2014 3:13:22 PM
Sent As: ECOM111@USPTO.GOV
Attachments:

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

U.S. APPLICATION SERIAL NO. 86018272

MARK: PERIWINKLE

86018272

CORRESPONDENT ADDRESS:

ROBERT J DOHERTY
ROBERT J DOHERTY ,ESQ
10 GEORGE ST
BARRINGTON, RI 02806-1719

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

APPLICANT: Barlow Designs, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

nockumhill@hughes.net

SUSPENSION NOTICE: NO RESPONSE NEEDED

ISSUE/MAILING DATE: 3/14/2014

The refusal to register due to a likelihood of confusion with the mark in U.S. Registration No. 3593654 is withdrawn.

The trademark examining attorney is suspending action on the application for the reason(s) stated below. *See* 37 C.F.R. §2.67; TMEP §§716 *et seq.*

The USPTO will periodically conduct a status check of the application to determine whether suspension remains appropriate, and the trademark examining attorney will issue as needed an inquiry letter to applicant regarding the status of the matter on which suspension is based. TMEP §§716.04, 716.05. Applicant will be notified when suspension is no longer appropriate. *See* TMEP §716.04.

No response to this notice is necessary; however, if applicant wants to respond, applicant should use the "Response to Suspension Inquiry or Letter of Suspension" form online at <http://teasroa.uspto.gov/rsi/rsi>.

The effective filing date of the pending application(s) identified below precedes the filing date of applicant's application. If the mark in the referenced application(s) registers, applicant's mark may be refused registration under Section 2(d) because of a likelihood of confusion with that registered mark(s). *See* 15 U.S.C. §1052(d); 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, action on this application is suspended until the earlier-filed referenced application(s) is either registered or abandoned. 37 C.F.R. §2.83(c). A copy of information relevant to this referenced application(s) was sent previously.

file:///D:/p2mp/temp/html/OEMS.htm

1/14/2015

- Application Serial No(s). 85106996, 85540923, and 85647204

REFUSAL(S)/REQUIREMENT(S) CONTINUED AND MAINTAINED: The following refusal (s)/requirement(s) is/are continued and maintained:

Applicant must submit a claim of ownership of the marks in U.S. Registration Nos. 3285250 and 3335997.

/Jonathan R. Falk/
Trademark Examining Attorney
Law Office 111
(571)272-5301
jonathan.falk@uspto.gov

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the Trademark Electronic Application System (TEAS) form at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.

To: Barlow Designs, Inc. (nockumhill@hughes.net)
Subject: U.S. TRADEMARK APPLICATION NO. 86018272 - PERIWINKLE - N/A
Sent: 3/14/2014 3:13:22 PM
Sent As: ECOM111@USPTO.GOV
Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

**IMPORTANT NOTICE REGARDING YOUR
U.S. TRADEMARK APPLICATION**

USPTO OFFICE ACTION (OFFICIAL LETTER) HAS ISSUED
ON **3/14/2014** FOR U.S. APPLICATION SERIAL NO.86018272

Please follow the instructions below:

(1) TO READ THE LETTER: Click on this [link](#) or go to <http://tsdr.uspto.gov/>, enter the U.S. application serial number, and click on "Documents."

The Office action may not be immediately viewable, to allow for necessary system updates of the application, but will be available within 24 hours of this e-mail notification.

(2) QUESTIONS: For questions about the contents of the Office action itself, please contact the assigned trademark examining attorney. For *technical* assistance in accessing or viewing the Office action in the Trademark Status and Document Retrieval (TSDR) system, please e-mail TSDR@uspto.gov.

WARNING

PRIVATE COMPANY SOLICITATIONS REGARDING YOUR APPLICATION: Private companies **not** associated with the USPTO are using information provided in trademark applications to mail or e-mail trademark-related solicitations. These companies often use names that closely resemble the USPTO and their solicitations may look like an official government document. Many solicitations require that you pay "fees."

Please carefully review all correspondence you receive regarding this application to make sure that you are responding to an official document from the USPTO rather than a private company solicitation. All official USPTO correspondence will be mailed only from the "United States Patent and Trademark Office" in Alexandria, VA; or sent by e-mail from the domain "@uspto.gov." For more information on how to handle private company solicitations, see http://www.uspto.gov/trademarks/solicitation_warnings.jsp.

*** User:tmcbride1 ***

#	Total Marks	Dead Marks	Live Viewed Docs	Live Viewed Images	Status/ Search Duration	Search
01	1	0	1	1	0:01	86201868[SN]
02	41	23	18	17	0:01	"per{"yie"}\$w{"yie"}n{"cxkq"}l* [bi,ti]

Session started 5/3/2014 8:23:38 AM
Session finished 5/3/2014 8:43:54 AM
Total search duration 0 minutes 2 seconds
Session duration 20 minutes 16 seconds
Default NEAR limit=1ADJ limit=1

Sent to TIGRS as Serial Number: 86018272

*** User:tmcbride1 ***

#	Total Marks	Dead Marks	Live Viewed Docs	Live Viewed Images	Status/ Search Duration	Search
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02	41	23	18	17	0:01	*per{"yie"}\$w{"yie"}n{"cxkq"}l* [bi,ti]

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Total search duration 0 minutes 2 seconds
Session duration 20 minutes 16 seconds
Default NEAR limit=1ADJ limit=1

Sent to TIGRS as Serial Number: 86018272